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10/762,663	01/22/2004	John E. Tadych	ABR-32112	5153
22202	7590	07/07/2009	EXAMINER	
WHYTE HIRSCHBOECK DUDEK S C INTELLECTUAL PROPERTY DEPARTMENT 555 EAST WELLS STREET, SUITE 1900 MILWAUKEE, WI 53202			MULCAHY, PETER D	
		ART UNIT	PAPER NUMBER	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JOHN E. TADYCH

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Appeal 2009-003327  
Application 10/762,663  
Technology Center 1700

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Decided:<sup>1</sup> July 7, 2009

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Before EDWARD C. KIMLIN, TERRY J. OWENS, and MARK NAGUMO, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 2, and 8-15. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6. Claim 1 is illustrative:

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the Decided Date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

1. A masking compound comprising a vulcanized rubber latex, at least one filler and aqueous ammonia.

The Examiner relies upon the following reference as evidence of obviousness:

Watanabe et al. (Watanabe) US 6,929,857 B2 Aug. 16, 2005

Appellant's claimed invention is directed to a composition comprising a vulcanized rubber latex, a filler, and aqueous ammonia. The composition finds utility as a masking compound.

Appealed claims 1, 2, and 8-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Watanabe.

Appellant has not presented an argument that is reasonably specific to any particular claim on appeal. Accordingly, all the appealed claims stand or fall together with claim 1.

We have thoroughly reviewed each of Appellant's arguments for patentability. However, we are in complete agreement with the Examiner that the claimed subject matter would have been obvious to one of ordinary skill in the art within the meaning of § 103 in view of the applied prior art. Accordingly, we will sustain the Examiner's rejection for essentially those reasons expressed in the Answer, and we add the following primarily for emphasis.

Appellant does not dispute the Examiner's factual determination that Watanabe discloses a composition comprising a vulcanizable rubber latex, a vulcanizing agent, at least one filler, and aqueous ammonia. Appellant contends that the latex of Watanabe "is not a vulcanized rubber latex, merely a vulcanizable latex" (Principal Br. 10, third para.).

Appellant acknowledges, however, that the reference composition comprises vulcanized rubber when it is on the glass fiber (Principal Br. 10, 2<sup>nd</sup> para). Consequently, Appellant has not established any distinction between compositions within the scope of claim 1 on appeal and the vulcanized rubber composition of Watanabe. It is of no moment whether the composition itself is in the form of a coating on a glass fiber or on some other unspecified substrate when acting as a masking compound. It is well settled that recitation of an intended use does not necessarily distinguish a composition that has been subjected to different uses. Furthermore, we agree with the Examiner that it is reasonable to conclude that the bath of Watanabe's composition used to treat the glass fiber will comprise some level of vulcanized rubber, which level is not specified by appealed claim 1. As acknowledged by Appellant, some of the rubbers disclosed by Watanabe are self-crosslinking (*see* Principal Br. 10, third para.).

Appellant also argues that the Examiner improperly failed to give weight to the claim recitation "[a] masking compound." However, we fully concur with the Examiner that the claim recitation is tantamount to a statement of intended use that does not further define compositions embraced by appealed claim 1. Appellant maintains that "the requirement that the invention is a masking compound imparts certain requirements and expectations in comparison to a generic compound or coating" (Principal Br. 9, last para.). However, Appellant does specify any particular property associated with compositions encompassed by claim 1 that is not present in the vulcanized rubber composition of Watanabe. Appellant submits that because Watanabe forms a permanent coating it cannot function as a

masking compound. However, claim 1 does not specify that the masking compound is not part of a permanent coating and Appellant has not established that the term "masking compound" has a meaning in the art that is associated with any property that is not possessed by Watanabe's vulcanized composition. Nor has Appellant established that it was known in the art that all masking compounds are readily removal from any substrate upon which they are coated. Indeed, Appellant's argument that the heating of Watanabe's composition "would render it impractical for many masking operations" indicates that the reference composition is suitable for some masking operations (Principal Br. 10, first para.).

As a final point, we note that Appellant bases no argument upon objective evidence of nonobviousness, such as unexpected results.

In conclusion, based on the foregoing, the Examiner's decision rejecting the appealed claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v)(2008).

AFFIRMED

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Appeal No. 2009-003327

Application 10/762,663

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